



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

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P. Miller
10/06/02

In re application of: Venegas, Jr.

Serial No.: 09/855,087

Group No.: 3628

Filed: May 14, 2001

Examiner: C. Davis

For: INTEGRAL POST SLEEVE AND SIGN

APPELLANT'S BRIEF UNDER 37 CFR §1.192

I. Real Party in Interest

The real party and interest in this case is the inventor, Mr. Frank Venegas, Jr.

II. Related Appeals and Interferences

There are no related appeals or interferences known to Appellant or Appellant's legal representative affected by, or which might have a bearing, on the Board's decision with respect to this appeal.

III. Status of the Claims

Claims 1-5 and 7-11 are now pending in this application. All are under final rejection.

IV. Status of all Amendments Filed Subsequent to Final Rejection

An after-final amendment is being filed herewith.

V. Concise Summary of the Invention

This invention addresses the combined need to cover certain types of upright members such as posts, stanchions, and the like, while, at the same time, providing for desired signage (Specification, page 2, lines 8-10). Broadly, this goal is achieved through the use of a combined sleeve having an open bottom to fit over a post or other vertical member, including an integrated message panel formed in the upped end when installed (Specification, page 2, lines 10-12). In terms of construction, the combined

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sleeve and sign holder according to the invention is made of a molded synthetic/polymeric material such as polyethylene, polypropylene, vinyl, or any other sufficiently durable material (Specification, page 2, lines 13-15). The article may be fabricated using any suitable process, though molding is preferred, whether an injection mold, blow mold, or rotational-type mold (Specification, page 2, lines 15-17). Depending upon the process used, the article may be fabricated as a unitary structure, or components may be joined through any suitable form of attachment process, including the use of adhesives and/or welding (Specification, page 2, lines 17-19). The message may be supported to the sleeve in a variety of ways, depending upon the need for interchangeability vs. permanence. A transparent forward panel may also be included to protect the signage (Specification, page 2, line 20 to page 3, line 1). In the preferred embodiment, the signage is fully integrated into the upped end through the use of decals, which are included in the mold and integrally formed with the article during the molding process (Specification, page 3, lines 1-3). In alternative embodiments a sign holder may be provided, enabling a changeable message to be loaded either from the front, or back, or both (Specification, page 3, lines 3-5).

VI. Concise Statement of Issues Presented for Review

- A. Is claim 1 (including the limitations of claim 6) anticipated by Garfinkle, U.S. Patent No. 4,777,750?
- B. Is claim 8 obvious over Garfinkle, U.S. Patent No. 4,777,750?
- C. Is claim 3 obvious over the combination of Garfinkle, U.S. Patent No. 4,777,750 and Shuman, U.S. Patent No. 4,329,800?

VII. Grouping of Claims for Each Ground of Rejection Which Appellants Contend

Appellant believes the following two groups of claims represent patentably distinct subject matter for separate consideration by the Board:

- Group I: Claims 1-5, 7 and 10, wherein claims 2-5, 7 and 10 stand or fall with claim 1.
- Group II: Claims 8, 9 and 11, wherein claims 9 and 11 stand or fall with claim 8.
- Group III: Claim 3

VIII. Argument

Group I: Claims 1-5, 7 and 10

By way of an amendment contemporaneous with the filing of this Appeal Brief, the limitations of claim 6 have been moved into claim 1. In the final Office Action, the Examiner claims that, with respect to claim 6, it has been held that the term "integral" is broad enough to include construction united by means such as fastening and welding, citing In re Hotte, 177 USPQ 326, 328 (CCPA, 1973). The present situation distinguishes over the facts of Hotte, however. In Hotte, Appellant relied on "integral" without further limiting language (a vitreous case surrounding an *integrally* united with the capacitor unit so formed," emphasis added). In the instant appeal, claim 1 (with the limitations of claim 6), includes not only integral formation, but the use of a molding process for doing so. This precludes construction united by such means as fastening and welding. The Board's attention is directed to the Appellant's disclosure at page 2, lines 13-19, wherein a preferred molding process is disclosed, along with an alternative fabrication process wherein the components may be joined through any form of attachment process, including the use of adhesives and/or welding. Accordingly, by choosing one of two disclosed alternative embodiments, Appellant has added sufficient elaboration to the use of the term "integral" so as to be given a patentable distinction over and above the facts of Hotte.

Group II: Claims 8, 9 and 11

Claim 8 includes the limitation of an elongated generally cylindrical sleeve of polymeric material having an inner diameter in the range of 2-8 inches, among other limitations. In rejecting this claim, the Examiner states that "applicant does not disclose that a sleeve having an inner diameter in the range of 2-8 inches solves any stated problem or is for any particular purpose, it appears the constructing of the sleeve of any suitable diameter would perform equally well." This is clearly not true. Appellant's combined sleeve and sign holder is specifically intended to cover an outside post/stanchion, the diameters of which are typically in the range of 2-8 inches, usually at even-inch increments (Specification, page 4, lines 4-8). As such, Appellant's stated purpose is explicit, and the Examiner is incorrect on this point.

Group III: Claim 3

Claim 3 includes the limitation that at least the sleeve is composed of a polymeric material. In rejecting this claim, the Examiner combined Garfinkle and Shuman, U.S. Patent No. 4,329,800. As Shuman does include plastic parts, the Examiner states that it would have been obvious to construct the device Garfinkle with the polymeric material of Shuman to provide a lightweight and less costly display device. However, it is well settled that in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Appellant's claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembicza, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, Garfinkle makes no mention whatsoever as to excess weight and, in fact, solves a different problem entirely, namely, the use of various interchangeable parts so that common pieces may be integrated without other pieces of a "kit" in order to enable one to achieve enhanced flexibility in dissimilar environments (column 1, lines 50-56). Garfinkle makes specific reference to metal frames, and includes multiple intricate component parts which could exhibit less structural integrity if constructed from plastic. Thus, in this sense, Garfinkle teaches away from the use of plastic parts. Given that there is no teaching or suggestion from the prior art to form the combination suggested by the Examiner, *prima facie* obviousness has not been established.

Conclusion

Based upon the foregoing, Appellant urges the Board's concurrence all pending claims are in condition for allowance.

Respectfully submitted,

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APPENDIX A**Appended Claims**

1. A combined stanchion cover and signage system, comprising:
an elongated sleeve having a closed top and an open bottom defining a length, enabling the sleeve to be placed over a post or stanchion to be covered; and
a message-bearing panel integrally formed with the sleeve using a molding process, the message-bearing panel extending above the closed end of the sleeve, the panel having a height which is substantially less than the length of the sleeve.
2. The combined stanchion cover and signage system of claim 1, wherein the sleeve is generally cylindrical in shape.
3. The combined stanchion cover and signage system of claim 1, wherein at least the sleeve is composed of a polymeric material.
4. The combined stanchion cover and signage system of claim 1, wherein the message-bearing panel includes a recess or slot to receive a separate sign.
5. The combined stanchion cover and signage system of claim 2, wherein the sleeve has an inner diameter in the range of 2 to 8 inches.
7. The combined stanchion cover and signage system of claim 1, wherein the message-bearing panel includes an informational decal included in the mold during the formation thereof.
8. A combined stanchion cover and sign holder, comprising:
an elongated generally cylindrical sleeve of polymeric material, having a closed top, an open bottom, and an inner diameter in the range of 2 to 8 inches; and
a sign holder extending above the closed top of the sleeve.

9. The combined stanchion cover and sign holder of claim 8, wherein the sign is a decal integrally formed in the sign holder.

10. The combined stanchion cover and signage system of claim 1, wherein the message concerns parking or traffic flow.

11. The combined stanchion cover and sign holder of claim 8, wherein the sign concerns parking or traffic flow.